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APR 30 2008

In re Application of	:	OFFICE OF PETITIONS
Steiss et al.	:	
Application No.: 10/773385	:	DECISION ON
Filing or 371(c) Date: 02/05/2004	:	PETITION
Attorney Docket Number: 6364	:	

This is a decision in response to the "Petition Under 3] C.F.R. § 1.181(a) to Withdraw a Holding of Abandonment – no Fee Required," filed March 27, 2008.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due (Notice), mailed November 8, 2007. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned February 9, 2008.

Petition under 37 CFR 1.181

Applicant petitions for withdrawal of the holding of abandonment and in support of the petition states that the Notice was never received. Applicant provides that prior counsel submitted a "Request for Withdrawal as Attorney or Agent and Change of Correspondence Address" on October 12, 2007 (prior to the mailing of the Notice). Applicant subsequently filed a Revocation of Prior Power of Attorney, Appointment of New Power of Attorney, and Statement Under 37 CFR 3.73(b) on January 24, 2008, that Applicant states was recognized by this Office on February 24, 2008.

Office records

A review of Office records confirm that Applicant filed a "Request for Withdrawal as Attorney or Agent and Change of Correspondence Address" on October 12, 2007, and a Revocation of Prior Power of Attorney, Appointment of New Power of Attorney, and Statement Under 37 CFR 3.73(b) on January 24, 2008.

Applicable Law, Rules and MPEP

The MPEP 711.03(c)A, Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action, provides

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions). (Emphasis supplied)

MPEP 711.03(c)

Analysis

A review of Office records reveals that the Office did not act on the Request for Withdrawal as Attorney or Agent and Change of Correspondence Address prior to the mailing of the Notice. 37 CFR 1.136(b) provides:

A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director.

Because the Office had not acted upon the Request for Withdrawal as Attorney or Agent and Change of Correspondence Address, the correspondence address was not changed. Applicant therefore could not rely upon the correspondence address included with the Request for Withdrawal as Attorney or Agent unless and until this Office approved the Request for Withdrawal as Attorney or Agent.

Applicant subsequently filed a proper Revocation of Prior Power of Attorney, Appointment of New Power of Attorney, and Statement Under 37 CFR 3.73(b) on January 24, 2008, and in accordance with 37 CFR 1.136(a), this Office changed the correspondence address of record.

Office records reveal that the Notice mailed November 8, 2007, was mailed to the correspondence address of record. Thereafter, Applicant changed his correspondence. As such, there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail.

Accordingly, the petition to withdraw the holding of abandonment is dismissed.

Alternate venue

Applicant is urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in was “unavoidable.” An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the required reply to the Notice and the petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

A copy of the Office communication is enclosed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300

Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this petition Decision should be directed to the undersigned at
(571) 272-3232.

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